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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/719,050

11/21/2003

Leon A. Pintsov

F-710

3291

7590

11/26/2007

Pitney Bowes Inc.  
Intellectual Property and Technology Law Dept.  
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EXAMINER

ELISCA, PIERRE E

ART UNIT

PAPER NUMBER

3621

MAIL DATE

DELIVERY MODE

11/26/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

### Application No.

10/719,050

### Applicant(s)

PINTSOV ET AL.

### Examiner

Pierre E. Elisca

### Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 September 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-52 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-33 is/are allowed.
- 6) ☒ Claim(s) 50-52 is/are rejected.
- 7) ☒ Claim(s) 34-49 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                                            |                                                                                         |
|------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                           | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

### **DETAILED ACTION**

1. This communication is in response to Applicant's response filed on 09/18/2007.
2. Claims 1-52 are currently pending.

### ***Allowable Subject Matter***

3. Claims 1-33 are allowed over the prior art of record.

### ***Claim Objections***

4. Claims 34-49 are objected to because of the informalities. Claim 34, line 16 recites the word "can be" which is analogous to may be, and therefore optional elements do not narrow the claim because they can always be omitted. "In re Johnson, 435 F.3d 1381, 77 USPQ2d 1788, 1790 (Fed. Cir. 2006)(where the federal Circuit affirmed the Board's claim construction of "further including that said wall may be smooth, corrugated, or profiled with increased dimensional proportions as pipe size is increased" since "this additional content did not narrow the scope of the claim because these limitations are stated in the permission form "may").

### ***Claim Rejections - 35 USC § 101***

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement

thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 34-49 are rejected under 35 U.S.C. 101 because it is directed to non-statutory subject matter specifically, as directed to an abstract idea.

Computer software program or code not claimed as embodied in computer-readable media are descriptive material per se are not statutory because they are neither physical thing nor statutory processes. The claim 34 recites "a programmable system for generating..." which do not define any structural and functional interrelationships with a general purpose computer for permitting the claimed functions to be realized. In contrast, a statutory claim would define structural and functional interrelationships between data structures or functional parts and a computer readable medium which permit the data functions to be realized. Thus, the claim is rejected as being non-statutory as described above. Applicant is advised to add a computer readable medium into the preamble of claims.

### ***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-52 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Montgomery et al (U.S. PG Pub No. 2003/0101143).

As per claims 50-52, Montgomery et al disclose a secure indicia printing system (*end user computer system, 308*) and method for generating a prisme digital image of said printed material, transform said prisme image in a manner corresponding to printing and scanning processes, generate characterizing information descriptive of said transformed image, and output said characterizing information for comparison with said printed material (*indicia, 100, 200*) on an object (*mail piece, 100*), comprising a printer (*printer 404*) for printing the indicium a scanner (*scanning station, 484*) for scanning an image of other printed material from the object, a processor communicating with the scanner to receive the image for processing the image to abstract the characterizing information from the image, the characterizing information being selected to fit within the indicium (*see abstract, figs 2, 3, 4, 5, 8, 19-22, pps 0006, 0034-0038, 0113-0114, 0116, 0134-0138*).

### **Conclusion**

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pierre E. Elisca whose telephone number is 571 272 6706. The examiner can normally be reached on 6:30 to 5:00. Patents and hoteling.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Fischer can be reached on 571 272 6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

November 15, 2007

  
PIERRE EDDY ELISCA  
PRIMARY EXAMINER  
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